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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,258	03/19/2001	Travis J. Parry	10004013-1	8434

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

SINGH, SATWANT K

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/02/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,258

Applicant(s)

PARRY, TRAVIS J.

Examiner

Satwant K. Singh

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2626

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 09/925,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter as follows:

Receiving data at a printer; detecting an external address in the received data; retrieving the document from the external address; and printing the document.

Art Unit: 2626

Claim 1 in the copending application fails to disclose detecting a barcode in the received data and translating the said barcode to an external address.

However, claim 3 of the copending application discloses that the method described in claim 1 comprises detecting a barcode in the received data and translating the barcode to the network address.

Therefore, it would be obvious to one having ordinary skill in the art claim 1 in the instant application is a combination of claims 1 and 3 in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 09/925,650. The conflicting claims are identical.

4. Claims 3 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 09/925,650. The conflicting claims are identical.

5. Claim 4 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 09/925,650. The conflicting claims are identical.

6. Claim 5 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 09/925,650. The conflicting claims are identical.

Art Unit: 2626

7. Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 09/925,650. Claim 18 in the copending application fails to indicate that a binary sequence is a barcode. However, claim 18 in the copending application indicates that the wrapped data is a barcode. The conflicting claims are obvious variations of each other.
8. Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 3 copending Application No. 09/925,650. Claims 7 and 8 are dependent on claim 1 in the instant application, which is an obvious variation of claims 1 and 3 of the copending application.
9. Claim 9 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 09/925,650. The conflicting claims are identical.
10. Claim 10 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 09/925,650. The conflicting claims are identical.
11. Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 09/925,650. Claim 21 in the copending application fails to translate the barcode to obtain at least one identifier that designates the type of contents. However, claim 21 of the copending application obtains at least

Art Unit: 2626

one identifier that designates the type of contents. The conflicting claims are obvious variations of each other.

12. Claims 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 09/925,650. Claims 12-15 are dependent on claim 10 in the instant application, which is identical to 20 of the copending application. The conflicting claims are obvious variations of each other.

13. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24 of copending Application No. 09/925,650. It is obvious that claim 22 in the instant application is the combination of claims 22-24 in the copending application.

14. Claim 22 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/925,650. Even though a specific claim does not exist in the copending application describing a system comprising the steps in claim 22, it would be obvious to one having ordinary art in the skill that since print stream data is being applied to the method described in claim 1 **[Paragraph 0030]**, a system comprising the steps in claim 22 is being described. Claim 22 is rejected for the same reason as claim 1.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is

Art Unit: 2626

important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

15. The abstract of the disclosure is objected to regarding the use of "Briefly" and "the present invention". Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 101***

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The terminology "machine readable code" alone has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium. See MPEP § 2106. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2626

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

18. Claims 1-8, 15-18, and 21-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Marx (US 6,348,970).

Regarding claims 1, 16, 21, and 22, Marx describes an apparatus and method for interfacing a facsimile machine with a computer network (abstract, lines 1-2). A printing method comprising the steps of receiving data at a printer (reads on fax machine) (col. 4, lines 51-54); detecting a bar code in the received data (reads on barcode) (col. 6, lines 22-23); translating the barcode to an external address (reads on URL) (col. 7, lines 30-35); sending on the Internet or other external network an access request for a document to the external network address (col. 4, lines 51-54); then retrieving the document from the external network address (reads on URL) (col. 11, lines 11-35); and printing the document. (col. 11, lines 31-35).

Regarding claim 2, Marx discloses that the control pages contain identifying information, control symbols, URL symbols, and skew indicators. The network address is a URL (reads on URL) (col. 6, lines 12-15).

Regarding claims 3-4, and 17, Marx discloses that the server can be modified to interface with gopher, ftp, telnet or e-mail protocols. Said receiving data step comprises receiving an e-mail (reads on e-mail) containing said data. (col. 12, lines 33-34).

Regarding claims 5 and 18, Marx discloses some exemplary user configuration information (including password) as listed in Table 2. Marx also

Art Unit: 2626

discloses that the user control page can contain a control symbol that will change user configuration information (col. 9, lines 21-23). This control page also contains the identifying information (barcode). The method wherein said translating step comprises translating the barcode to obtain a PIN# (reads on password); and wherein said sending step includes sending the PIN# with the access request to the external network address for determining if the request is authorized (col. 9, lines 24-31).

Regarding claim 6, Marx discloses that the identifying information can contain unique codes and can take various printed form such as a barcode (col. 6, lines 16-26)

Regarding claims 7 and 8, Marx discloses some exemplary user configuration information (paper size, number of prints, default fax number, page forwarding/duplicating etc.) as listed in Table 2. Marx also discloses that the user control page can contain a control symbol that will change user configuration information (col. 9, lines 21-23). The method further comprising the steps for displaying a field for a transmission address (reads on default fax number) (Table 2); receiving a transmission address for another device in said field; and sending the document to said another device (reads on page forwarding) (Table 2).

Regarding claim 15, as best understood from the language of the claim are rejected for the same reasons as claim 1.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

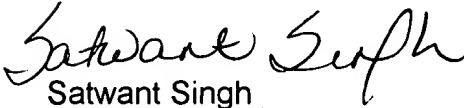
20. Claims 9-14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marx (US 6,348,970) in view of Wolff (US 5,848,413). Marx does not specifically disclose printing the document within another document and identifying the type of contents of the document. Wolff discloses locating/identifying and retrieving the documents over the Internet (col. 6, lines 29-37). Wolff also discloses retrieving not only a requested page, but also all or some number of pages pointed to by that page (col. 6, lines 58-62). Wolff also discloses designating the type of contents (which reads on a form) (col. 6, lines 23-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Marx by the teaching of Wolff to allow greater user control of the formatting of the retrieved documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

Art Unit: 2626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Satwant Singh

Satwant K. Singh  
Examiner  
Art Unit 2626

  
MARK WALLERSON  
PRIMARY EXAMINER